

## REMARKS

This Reply is in response to the non-final Office Action dated August 6, 2004. The foregoing claims are presented for reconsideration and allowance.

### I. Objection to the Drawings.

Paragraph 1 of the Office Action objected to the drawings by asserting they include reference characters "40", "1107", and "2110" which are not mentioned in the description. In response, Figure 1 is amended as to cancel reference character "40" and Figure 11 is amended to cancel reference character "2100".

Paragraph 2 of the Office Action objected to the drawings by asserting they do not include reference sign "1102". In response, Figure 11 is amended to replace reference sign "1107" with "1102". Accordingly, Applicants request that the objections to the drawings be withdrawn.

### II. Specification.

Paragraph 3 of the Office Action objected to the disclosure by noting informalities on page 8 of the specification. In response, the specification is amended to correct these typographical errors. Accordingly, Applicants request that the objection to the disclosure be withdrawn.

### III. Objection to the Claims.

Paragraph 4 of the Office Action objected to claims 4-6 noting several informalities. Claims 4 and 5 have been amended to correct this typographical error. The scope of claims 4 and 5 is not changed by this amendment. Claim 6 is cancelled, thus rendering moot the rejection thereof. Accordingly, Applicants request withdrawal of the objection to the claims.

### IV. Rejection of Claims 2, 3, 7, 10, 11, 17, 19, 22-26 and 29 Under 35 U.S.C. § 102(b) Based Upon Uehara.

**Amendments to the Drawings:**

The drawings are amended to cancel reference characters 40 and 2110. The drawings are also amended to replace reference character 117 with 1102.

Replacement sheets including these changes are filed herewith.

Paragraph 5 of the Office Action rejected claims 2, 3, 7, 10, 11, 17, 19, 22-26 and 29 under 35 U.S.C. § 102(b) as being anticipated U.S. Patent No. 5,737,679 to Uehara. These claims, as amended, overcome the rejection based upon Uehara.

A. Claims 2, 3, 7, 10, and 11.

Paragraph 14 Of the Office Action identified claim 8 as defining allowable subject matter. Applicants are re-writing claim 8 in independent form. Claim 2 is cancelled. Claims 3, 7, 10, and 11 are amended to depend upon claim 8 and are allowable at least by virtue of their dependency upon claim 8. Withdrawal of these rejections is requested.

B. Claims 17 and 19

Claim 17 is cancelled, thus rendering moot the rejection thereof.

Paragraph 14 Of the Office Action identified claim 20 as defining allowable subject matter. Applicants are re-writing claim 20 in independent form. Claim 19 is amended to depend upon claim 20. Applicant submits that claim 19 is allowable for at least the same reasons as claim 20. Withdrawal of these rejections is requested.

C. Claim 22

Independent claim 22 is cancelled, thus rendering moot the rejection thereof.

D. Claims 23-26 and 29

Paragraph 14 Of the Office Action identified claim 28 as defining allowable subject matter. Applicants are re-writing claim 28 in independent form. Claim 23 is cancelled. Claims 24, 25, and 29 are amended to depend upon claim 28 and are allowable for at least the same reasons as claim 28 is allowable. Withdrawal of these rejections is requested.

V. Rejection of Claims 17 and 18 Under 35 U.S.C. § 102(b) Based Upon Kishi.

Claim 17 is cancelled, thus rendering moot the rejection thereof.

Claim 18 is amended to depend upon claim 20 and is allowable for at least the same reasons claim 20 is allowable. Withdrawal these rejections is requested.

VI. Rejection of Claims 2-7, 10, and 11 Under 35 U.S.C. § 103(a) Based Upon Kishi in view of Uehara.

Claim 2 is cancelled, thus rendering moot the rejection thereof.

Claims 3-7, 10, and 11 are amended to depend upon claim 8. Applicants submit that these claims are allowable for at least the same reasons claim 8 is allowable. Withdrawal of these rejections is requested.

VII. Rejection of Claims 1, 13-15, 23-27, and 29 Under 35 U.S.C. § 103(a) Based Upon Hediger in view of Uehara.

Claim 1 stands rejected as unpatentable over Hediger in view of Uehara. Applicants traverse this rejection on the basis that the Office Action does not establish a *prima facie* case of obviousness against claim 1.

To establish a *prima facie* case of obviousness, "there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings." (See, MPEP 2143).

Here, the Office Action alleges that:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the inner roller having a convex outer surface as taught by Uehara et al. to the inner rollers of Hediger to obtain a substantially even nipping width. (citation omitted). Office Action, Page 9, lines 3-6.

It would not be obvious to modify the inner rollers of Hediger as proposed in the Office Action “to obtain substantially even nipping width” because Hediger teaches modification of the nip width by a different principle of operation. (“The proposed modification cannot change the principle of operation of a reference,” MPEP 2143.01). Specifically, in this regard, Hediger teaches that “[t]he width of the nip 23 may be lengthened or shortened by changing the center distance between the driver rollers 13 and 16 and the center distance between driver rollers 14 and 15.” (Hediger, Col. 3, lines 46-49).

Thus, Hediger teaches modification of nipping width by changing distances between certain rollers. This principle of operation is quite different from that of the modification proposed in the Office Action, namely applying “the inner roller having a convex outer surface”. Because the modification proposed by the Office Action changes the principle of operation of Hediger, Applicant submits that the Office Action fails to establish a *prima facie* case of obviousness of claim 1 based on Hediger in view of Uehara. (See, MPEP 2143.01, “If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.”) Accordingly, Applicants request withdrawal of this basis of rejection.

Claims 13-15, 23-27, and 29 also stand rejected as unpatentable over Hediger in view of Uehara. As discussed above, Applicants traverse the combination of Hediger and Uehara as proposed in the Office Action and submit that the Office Action fails to establish a *prima facie* case of obviousness for claims 13-15, 23-27, and 29. Withdrawal of these rejections is requested.

#### VIII. Allowable Subject Matter.

Applicants gratefully note the acknowledgement of allowable subject matter on page 9 of the Office Action. Specifically, the Office Action states that claims 8, 12, 16, 20, and 28 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form inkling all of the limitations of

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the base claim and any intervening claims. Applicants have rewritten claims 8, 12, 20, and 28 in independent form and submit that the objections to these claims are overcome.

Claim 16 depends upon claim 13, which, as discussed above, Applicants submit is allowable. Withdrawal of the objections to these claims is requested.

IX. Conclusion.

After amending the claims as set forth above, Applicants believe that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 08-2025. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 08-2025. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 08-2025.

Respectfully submitted,

Date

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By

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